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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,314	07/24/2003	Lothar Schwink	DEAV2002/0052US NP	1943

7590 10/24/2005

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EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,314

Applicant(s)

SCHWINK ET AL.

Examiner

EBENEZER SACKKEY

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/20/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Status of Claims

Claims 1-25 are pending.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed 08/20/03 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

Response to Restriction

Applicant's election with traverse of Group I, species of Example 1, 1-[4-(2-dimethylaminoethoxy)phenyl]-3-(4-phenoxyphenyl)-1,3-dihydroimidazol-2-one in the reply filed on 08/18/05 is acknowledged. The traversal is on the ground(s) that there is

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no undue burden on the Examiner to search the entire application because all the claims have a single class in common (class 514) and the product, process of making them and their use should be rejoined in pursuant to MPEP 821.04. This is not found persuasive because contrary to applicants assertion, a plethora of subclasses under class 514 must be searched in addition to classes 540, 546 and 548 and further search in non-patent literature which clearly constitutes an undue burden to the Examiner. Furthermore, examining Groups II-V (methods claims) in addition to Group I would raise different issues of patentability as additional consideration for compliance with 35 USC 112, most notably the question of sufficiency of dosage regimens that are commensurate in scope with all pairs of active ingredients embraced for all uses being claimed. Moreover, each specific medical condition in Groups II-V is independent from the other since, for example, the treatment of obesity is completely different from the treatment of psychiatric related diseases.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the "open-ended" phrase ---comprising--- in the definition of B renders the claims indefinite because comprising permits the inclusion of unrecited elements.

The elected species is free of art, however, the following rejection applies to compounds of structural formula (I).

Claim Rejections - 35 USC § 102

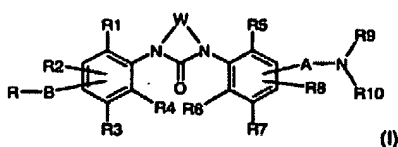
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Himmelsbach et al., (U.S. Patent number 5,276,049)('049').

Applicants claim compounds and compositions containing compounds of structural formula (I), wherein all the substituents are as defined in claim 1.



Himmelsbach et al., is replete with several anticipatory compounds far too many to list. See for example column 68, Example 8: 1-(4-aminomethyl-phenyl)-3-(4-methoxycarbonylmethoxy-phenyl)-imidazolidin-2-one hydrochloride; column 69, compound number 3: 1-[4-(2-amino-2-methoxycarbonyl-ethyl)-phenyl]-3-(4-aminomethyl-phenyl)-imidazolidin-2-one dihydrochloride.

It is suggested that applicants amend the elected claims to obviate this rejection.

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Allowable Subject Matter

Claim 8 is allowed over the prior art of record.

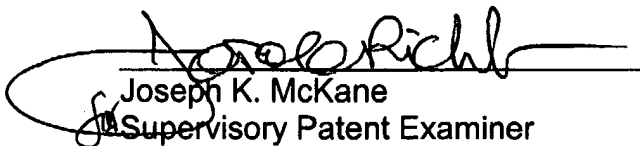
Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS
October 14, 2005


Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1600
Technology Center 1